Decision for dispute CAC-UDRP-103740

Case number	**CAC-UDRP-103740**
Time of filing	**2021-04-19 09:38:27**
Domain names	**industeels.com**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**INDUSTEEL France**

Complainant representative

Organization	**Nameshield (Laurent Becker)**

Respondent

Name	**Albert Zaidner**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of registered INDUSTEEL® trademarks, such as:
- International trademark n° 947686 INDUSTEEL® registered on October 05th, 2000;
- US trademark n° 2598096 INDUSTEEL® registered on October 09th, 2000; and
- EU trademark n° 1920438 INDUSTEEL® registered on October 06th, 2000.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant contends that the addition of the letter “S” in the trademark is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark INDUSTEEL®. It does not change the overall impression of the designation as being connected to the Complainant’s trademark INDUSTEEL®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the associated domain names. Numerous UDRP decisions have recognized that the addition of a geographic term associated to a trademark does not create a new or different right to the mark or diminish confusing similarity. Please see CAC Case No. 103617, Intesa Sanpaolo S.p.A. vs. Carmela

D'ambrosio, (“The disputed domain name incorporates the Complainant's trademark "INTESA SANPAOLO" in its entirety, except that the first letter "O" is substituted with the number "0". Such small difference has no effect whatsoever on the overall similarity between the "INTESA SANPAOLO" trademark and the "INTESANPA0LO" element in the disputed domain name, both phonetically and visually.”).

Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. See WIPO Case No D2004-0673 Ferrari Spa v American Entertainment Group Inc (“Complainant’s trademark is well-known and Respondent undoubtedly knew about it when registering the contested domain name.”).

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).
The addition of the letter “S” to the trademark, to comprise the disputed domain, is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark INDUSTEEL®. It does not change the overall impression of the designation as being connected to the Complainant’s trademark INDUSTEEL®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the associated domain names.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).
The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.
The Complainant asserts that the Respondent is not known as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. Please see for instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).”).
The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name <industeels.com> and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.
Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark INDUSTEEL®, or apply for registration of the disputed domain name by the Complainant.
Besides, the disputed domain name is inactive. The Complainant’s contends that the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name < industeels.com >, or a legitimate non-commercial or fair use of it.
Thus, in accordance with the foregoing, the Respondent has no right or legitimate interest in respect of the disputed domain name <industeels.com>.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).
The Complainant has proved that the disputed domain name <industeels.com> is confusingly similar to its distinctive trademark INDUSTEEL®. Given the distinctiveness of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.
Furthermore, the disputed domain name is currently inactive, but MX servers are configured, meaning that emails can be sent from an address which would be likely to make a recipient believe that it is a legitimate communication from Complainant.
The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law. Respondent has failed to appear or otherwise rebut any of these reasonable contentions.
Thus, Respondent has registered the disputed domain name <industeels.com> and is using it in bad faith.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name is currently inactive, but MX servers are configured, meaning that emails can be sent from an address which would be likely to make a recipient believe that it is a legitimate communication from Complainant.

The Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would be legitimate. Respondent has failed to appear or otherwise rebut any of the Complainant's reasonable contentions.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **INDUSTEELS.COM**: Transferred

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2021-05-17

Publish the Decision